

1. Status of the Claims.

Claims 1-12 and 21-24 are pending and under consideration in this application. This response contains no claim amendments and, therefore, the claims remain as submitted in the Request for Continued Examination filed June 23, 2005

2. Continued Examination Under 37 C.F.R. §1.114.

Applicant thanks Examiner Jackson for acknowledging Applicant's Request for Continued Examination and entering the amendments contained therein.

3. Rejections to the Claims Under 35 U.S.C. §103.

Claims 1-12 and 21-24 were rejected under 35 U.S.C. §103 over the prior art illustrated in FIGS. 1-4 (the "Applicant's Prior Art") of the present application in view of U.S. Patent No. 4,172,423 to Monne. More specifically, Examiner asserts that prior art FIGS. 1-4 show all the features of the claimed invention except at least one of the auxiliary wheels being dimensioned smaller than the trolley wheels. Examiner relies on rollers 20 of Monne as disclosing the smaller dimension of the claimed auxiliary wheels, and concludes that it would be obvious to modify the auxiliary wheels of prior art FIGS. 1-4 to have the smaller size of rollers 20 of Monne. Col. 4, lines 29-31. Applicant respectfully disagrees.

It is well settled that "the Examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)); See generally MPEP § 2143, page 2100-129. It is equally well settled that prior art references are properly combined only where there is a suggestion, teaching, or motivation to combine them, and that suggestion, teaching, or motivation must come from the prior art references themselves. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998); See generally MPEP § 2143, page 2100-129. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01, page 2100-131 (citing *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990)).

Applicant respectfully submits that neither Monne nor the Applicant's Prior Art illustrated in FIGS. 1-4 ("Applicant's Prior Art") contain any suggestion, teaching, or motivation to combine the two. The auxiliary wheels 101 of Applicant's Prior Art are structurally and functionally different from rollers 20 of Monne. Furthermore, wheels 101 of Applicant's Prior Art address and solve problems significantly different from those addressed and solved by rollers 20 of Monne. Finally, even assuming for the sake of argument the combination of these references, the resulting structure does not render the claimed invention obvious.

Applicant's Prior Art teaches the positioning of auxiliary wheels 101 within the track such that wheels 101 function to ride on the surface of track and support weight of trolley and wall panel. Furthermore, wheels 101 are positioned non-collinear relative to one another. In other words, the two wheels 101 are positioned on opposite ends and opposite sides of the trolley body relative to one another.

In contrast Monne teaches positioning rollers beneath the track. See Monne, Col. 4, line 30. Monne shows the rollers on both sides of the trolley body as well as on both ends of the trolley body. See Monne, Figs. 1 and 3. The rollers of Monne do not function to support the weight of the trolley and wall panel. In fact, the rollers of Monne frustoconical rollers that have a curved generatrix, which serves its function to prevent tipping but diminishes its ability to support the weight of the trolley. See Monne, Col. 4, lines 27-31. Rather, the rollers of Monne address the problem of the trolley tipping within the track, by positioning the rollers beneath the track such that the rollers bear against the underside of the track and restrict the tilting/tipping movement of the trolley. See Col. 4, lines 30-31. To serve this purpose, it is necessary to have the rollers of Monne on both sides of the track as well as both ends of the trolley body. Accordingly, nothing in either of these references suggests that the rollers of Monne could be combined with the trolley of Applicant's Prior Art to yield the claimed invention.

Furthermore, it is improper to combine references where the proposed modification would render the prior art unsatisfactory for its intended purpose. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended

purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984)). In addition,

[w]hile the test for establishing an implicit teaching, motivation, or suggestion is what the combination of [prior art references] would have suggested to those of ordinary skill in the art, the [prior art references] cannot be viewed in the abstract. Rather they must be considered in the context of the teaching of the entire reference. . . . [P]articular findings must be made as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected these components for combination in the manner claimed.

In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (emphasis added); See generally MPEP § 2143.01, page 2100-130.

Monne teaches positioning rollers beneath the track to prevent tipping. Col. 4, lines 30-31. Monne does not suggest, motivate, or teach including smaller dimensioned rollers within the track. In fact, if the rollers of Monne are combined with Applicant's Prior Art to yield the auxiliary wheels of the claimed invention, as suggested by the Examiner, the rollers must be positioned within the track. However, the teaching of Monne dictates positioning the frustoconical rollers as buffers arranged to engage against the underside of the track. Col. 4, lines 30-31. The Examiner's proposed modification of Monne would thus render Monne inoperable for its intended purpose. If the rollers of Monne are positioned within the track and in a non-collinear relationship to one another, the problem of the trolley tipping would not be solved. To prevent tipping, the rollers must be positioned beneath the track and rollers must be located on both opposite ends and both opposite sides of the trolley.

The Examiner mentioned the motivation for smaller auxiliary wheels being uniform load distribution, yet there is no suggestion or teaching in Applicant's Prior Art or Monne for such a result -- in fact, this is contrary to the teaching of Monne. The Examiner has not provided a cogent argument of how one of ordinary skill would contravene the teaching of Monne to modify the structure of Applicant's Prior Art as suggested. Accordingly, it is improper to combine the rollers of Monne with Applicant's Prior Art in the manner proposed by the Examiner.

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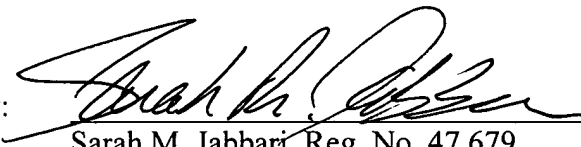
For the reasons discussed above, the claims of the present invention are patentable over the cited references.

CONCLUSION

Applicant respectfully requests that action toward a Notice of Allowance be taken.

Applicant believes that no fees are due in connection with this submission. However, if any fees are necessary, please charge Deposit Account No. 02-0390, Baker & Daniels LLP.

Respectfully Submitted,

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